



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/580,041

05/19/2006

Toshinori Moriga

MORIGA2

7553

1444 7590 08/06/2010  
BROWDY AND NEIMARK, P.L.L.C.  
624 NINTH STREET, NW  
SUITE 300  
WASHINGTON, DC 20001-5303

EXAMINER

LEONARD, MICHAEL L

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/06/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***ATTACHMENT TO ADVISORY***  
***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 05/21/2010 was filed after the mailing date of the Final Rejection on 04/28/2010. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Applicant's arguments filed 07/27/2010 have been fully considered but they are not persuasive. Applicants argue that the claimed invention has not been rendered obvious by Moriga ('1043) in view Klosowski ('2145) and Brinkman ('2956) for one reason.

1) The combination of references do not disclose or suggest the improvement in low swelling with an alcoholic beverage; low absorption of the odor of an alcoholic beverage; toughness; and no yellowing and that these results are unexpected as evidenced by Table 1, Page 6 of PG-Pub. 2009-0318657.

Firstly, in order to rebut a prima facie case of obviousness the applicants' must provide data that compares the claimed subject matter with the closest prior art. In the instant case, the closest prior art is not only the Moriga reference, but it is the combination of references to Moriga ('1043) in view Klosowski ('2145) and Brinkman ('2956). The comparison data disclosed in Table 1 of the instant application (comparative examples 1 and 2) only represent the prior art to Moriga

Art Unit: 1796

because the third component (glycerin fatty acid ester) is not present. Therefore, this is not a reasonable comparison to the closest prior art that suggests the first two components of Moriga and the third component disclosed by Klosowski and Brinkman. The amount of the third component and the reason for adding the third component are clearly laid out in the Klosowski and Brinkman references and have been discussed. Therefore, all the claimed effects and the reasons for the combination were taught in the prior art and the composition as a whole is not novel.

Secondly, the fact that the applicants found unexpected properties does not show that the composition as a whole is unexpected, especially when considering the combination of references.

Thirdly, the data presented in Table 1 fails to show a trend that the addition of component C always shows improvement in low swelling with an alcoholic beverage; low absorption of the odor of an alcoholic beverage; toughness; and no yellowing. It fails to show a trend because 1) there are only two comparison examples, 2) the consumption of potassium permanganate is virtually the same for each example including the comparison examples, and 3) the residual properties of Whiskey Odor was measured qualitatively and not quantitatively. Therefore, it is difficult for a person of ordinary skill in the art to understand the true effects of alcohol odor with the addition of the 3rd component, which is a property the applicants' claim to be unexpected.

Art Unit: 1796

In conclusion, while the applicants' alleged improvement in low swelling with an alcoholic beverage; low absorption of the odor of an alcoholic beverage; toughness; and no yellowing has been noted, it fails to overcome the current prima facie case of obviousness since the selection of the glycerine fatty acid ester component is not unobvious, based on the teachings of Klosowski and (Brinkman, 0035 and 0004). Furthermore, 2 of the 3 claimed unexpected properties do not appear to be unexpected because of the reasons stated above.

/Milton I. Cano/  
Supervisory Patent Examiner, Art Unit 1796